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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,058	05/22/2001	Hania Gajewska	14695.005001; P5114	7385
32615	7590	05/04/2005	EXAMINER	
OSHA LIANG L.L.P./SUN 1221 MCKINNEY, SUITE 2800 HOUSTON, TX 77010			LAO, SUE X	
			ART UNIT	PAPER NUMBER

2194

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,058

Applicant(s)

GAJEWSKA ET AL.

Examiner

Sue Lao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-46 are pending. This action is in response to the amendment filed 9/16/2004. Applicant has amended claim 39.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of independent claims 1-38 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claims 1 and 23 do not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of the claims. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998).

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MPEP 2106. State Street required transformation of data by a machine before it applied the “useful, concrete, and tangible” test. However, State Street does not hold that a “useful, concrete and tangible result” alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention, appearing to be comprised of software alone without claiming associated computer hardware required for execution, is not supported by either a specific and substantial asserted utility (i.e., transformation of data) or a well established utility (i.e., a practical application).

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-38 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are computer hardware necessary to execute the claimed software and render the invention operative.

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over IBM ((BM TDB "Technique to Move Focus in Presentation Manager Applications").

Regarding claims 39-42, 45, 46, broadly as disclosed, an opposite field refers to the counterpart event of a pair of events. See application as filed, paragraphs [0021], [0039], [0040].

As to claim 39, IBM teaches focus event processing (move focus using focus table), including

maintaining a list of components requesting focus in a selected application (focus table, second row, 2nd through 7th elements),

determining an opposite field (focus table, second row, first C21 (which corresponds to the 'tab' element), page 2, line 11) of a first focus event (page 2, line 9, element 'tab') based on a target of the first focus event (the control to move focus to via 'tab') and the list of components requesting focus (focus table, second row, 2nd through 7th elements). See pages 1-2.

As to determining an opposite field of a second focus event based on a target of the second focus event and the list of components requesting focus, these are similar operations applied to the second focus event. IBM teaches multiple focus events (tab, btab, rarr, larr, darr, uarr, page 2, line 9) handled in the same manner by using the same focus table and locating fields/elements corresponding to various focus events of interest. Therefore, it would have been obvious to process the second focus event in the manner as the first, ie, determining an opposite field of a second focus event based on a target of the second focus event and the list of components requesting focus.

Performing the steps with a program and storing such a program in a computer readable medium would have been obvious.

8. Claims 40-42, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM as applied to claim 39 in view of Brusky et al (U S Pat. 6,262,7130).

As to claims 40-42, Brusky teaches focus event processing , wherein the focus events are generated as a result of a operation / user clicking on a focusable

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component (button press). Event generation through function invocation is another typical source of event generation. Given the teaching of Brusky, it would have been obvious to generate focus events with operation / user clicking / function invocation. One of ordinary skill in the art would have been motivated to combine the teachings of IBM and Brusky because provided a virtual keyboard which allows operations of multiple applications without modifying the behavior of the underlying applications (col. 2, lines 56-62).

As to claim 45, adding to one end / tail and removing from the other end / head are conventional (FIFO) queue operations. It is noted that a list data structure is typically implemented with a queue data structure. Therefore, it would have been obvious to implement the list of IBM as modified with a queue and related queue operations.

As to claims 46, IBM as modified (Brusky) teaches the target of the first focus event is the current focus owner (Brusky, handler having the focus, col. 8, lines 49-57) and the target of the second focus event is the component gaining focus (Brusky, release focus, col. 8, lines 39-64) (IBM, control to move focus to, page 1, typedef struct).

9. Claims 1-38 would be allowable over prior art on record if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

10. Claims 43, 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Applicant's arguments filed 9/16/2004 have been considered but are moot in view of the new ground(s) of rejection.

As to the argued a list of focus event (Remard, page 10-11), this is met by IBM, focus table, for example, second row, 2nd through 7th elements corresponding to focus owner C12. It is noted that a table is a list in terms of data structure.


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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (571) 272-3764. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (571) 272 3756. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 29, 2005


SUE LAO
PRIMARY EXAMINER